PATENT
ATTORNEY DOCKET NO. 04712/050002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Rosenberg et al.	Confirmation No.:	1791
Serial No.:	10/822,540	Art Unit:	1615
Filed:	April 12, 2004	Examiner:	Carlos A. Azpuru
Customer No.:	21559		
Title:	OSTEOINDUCTIVE BONE MATERIAL		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

Applicants respectfully request withdrawal of finality of the Office Action delivered electronically in connection with the above-referenced application on April 19, 2010.

Under M.P.E.P. § 706.07, "the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection." This section also states that the "applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in prosecution of his or her application." The M.P.E.P. § 706.07(d) also states that "If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection." Finally, the M.P.E.P. § 706.07(e) states "The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are

presented such as to convince the examiner that the previously rejected claims are in fact allowable or patentable in the case of reexamination, then the final rejection should be withdrawn."

The facts of the case are as follows. On June 8, 2009, Applicants filed a request for continued examination and a reply that addressed the Office's prior written description rejection of claims 3, 4, 7-10, 15, 18-22, 33, and 36. Applicants' remarks overcome the written description rejection. On September 9, 2009, the Office issued a non-final action rejecting claims 1, 3, 4, 7-37, and 84-94 for obviousness-type double patenting over claims 1-34 and 37-41 of U.S. Serial No. 10/298,112 (now U.S. Patent No. 7,582,309). Applicants responded on February 9, 2010, by filing a terminal disclaimer over U.S. Patent No. 7,582,309.

On December 23, 2009, prior to the filing of Applicants' Reply to Office Action, Applicants submitted an information disclosure statement. One of the references cited therein, Lee et al. (U.S. Patent Application Publication No. 2003/049329 A1), is now cited by the Office in an Office Action dated April 19, 2010, in a rejection against claims 1, 3, 4, 7-37, and 84-106 under 35 U.S.C. § 102(a). The Office made the Office Action final, stating:

> Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 02/09/2010 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

(Office Action, dated April 19, 2010; emphasis in original.)

Applicants submit that finality was premature in this case. The Office, without

detailed explanation and without directing Applicants to any paragraph in Lee et al., states:

> Lee...et al disclose an ostoinductive powder comprising a demineralized bone matrix (DBM) and a calcium phosphate powder. The percentage of demineralized bone matrix is within the claimed percentage, as is the size of the DBM particles. Biologically active agents are also included. The ratio of calcium to phosphate is also set out fibrous embodiments having the instantly claimed characteristics. The instant claims are anticipated by Lee Dosuk et al.

(Office Action, pp. 2-3.) Applicants have thoroughly studied Lee et al. and can find no teaching at all of an osteoinductive powder having each and every limitation of pending claims 1, 3, 4, 7-37, and 84-106. Applicants particularly note that they can find no teaching at all in Lee et al. of compositions that include demineralized bone matrix particles having a particle size of less than about 850 μm, as recited in, e.g., claims 7 and 44, which depend from independent claims 1 and 37, respectively.[1] The Office's general statements about Lee et al. are insufficient to provide Applicants with notice as to how Lee et al. meets each and every limitation of claims 1, 3, 4, 7-37, and 84-106, which is required to establish the rejection of a claim for anticipation. Accordingly, Applicants can only surmise as to how the Office is applying the teachings of Lee et al. to claims 1, 3, 4, 7-37, and 84-106. Given the absence of any analysis explaining how Lee et al. anticipates claims 1, 3, 4, 7-37, and 84-106, Applicants lack a sufficient factual basis upon which to rebut the Office's novelty rejection of claims 1, 3, 4, 7-37, and 84-106 in view of Lee et al. For this reason, Applicants respectfully request withdrawal of finality of the present Office Action to allow Applicants a fair opportunity to respond to the new

1 Applicants have concurrently filed a Reply to Office Action, in which claims 7 and 44 are cancelled and the limitations of these claims are incorporated into independent claims 1 and 37, respectively.

ground of rejection. In the alternative, Applicants request that the Office enter the claim amendments submitted in the concurrently filed response to the final Office Action because it places the claims in better condition for appeal.

CONCLUSION

Applicants should not be prematurely cut off from prosecution while seeking the patent protection to which they are justly entitled. Applicants are entitled to a full opportunity to present additional arguments and evidence to develop a clear issue prior to any appeal. Applicants respectfully request withdrawal of finality.

If there are any charges or any credits, kindly apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: June 21, 2010

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